SUPREME COURT, U. S.

Supreme Court, U. S.
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1973

No. 73-1098

LOUIS GILBERT DUBUIT,

Petitioner,

vs.

HARWELL ENTERPRISES, INC. and ROY M. HARWELL, JR.,

Respondents.

Petition For Writ Of Certiorari To The United States Court Of Appeals For The Fourth Circuit

BRIEF FOR RESPONDENT IN OPPOSITION

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LOUIS GILBERT DUBUIT,

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Petition For Writ Of Certiorari To The United States Court Of Appeals For The Fourth Circuit

BRIEF FOR RESPONDENT IN OPPOSITION

OPINIONS BELOW.

These are correctly set forth in the Petition.

JURISDICTION.

Petitioners have invoked the jurisdiction of this Court under Sections 1254 and 2101 of the Judicial Code.

THE PETITION PRESENTS ONLY FACTUAL QUESTIONS—THRICE HELD AGAINST PETITIONER

The "Questions Presented" related to:

1. Purging of patent misuse, and,
2. Patent infringement.

Both of these questions have been held by this Court to be factual (*B.B. Chemical* v. *Ellis*, 314 U.S. 495; *Graver Tank & Mfg. Co. Inc. et al.* v. *The Linde Air Products Company*, 339 U.S. 605).

The District Court viewed the misuse as not purged and the patent not infringed. The jury so held. A unanimous Court of Appeals affirmed. Hence the "Questions Presented" relate solely to issues of fact and do not present any issues of law which may properly be considered here.

STATUTES AND RULES INVOLVED.

Supreme Court Rule 19(1) (b) involved by Petitioner is inapplicable since:

(a) No decision of any other court relating to Petitioner's patent 3,090,300 exists, much less conflicts with the unanimous decision of the Court of Appeals, and,

(b) With Judge, Jury, and Court of Appeals holding unanimously against Petitioner on the "Questions Presented" it is inconceivable that they all have:*

"So far departed from the accepted and usual course of judicial proceedings"

as to warrant review by this Court pursuant to Rule 19.

Thus we submit Rule 19 is inapplicable.

STATEMENT OF CASE.

Prior to charging the Jury, out of the presence of the Jury, and after the close of evidence the Trial Court commented:

> "I don't have any faith in submitting any of this case to the jury but I'm going to submit it all and do whatever good conscience indicates if they get too far off the track. If I were trying it without a jury, I would find that the patent is invalid; that the misuse has not been purged; that there's been no infringement and no damages; and that Mr. Dubuit is entitled to about $50.00 for defamation. A good thing I'm not trying it without a jury." (A. 670)

Thus, had the case not been tried to a Jury, the results would have been the same.

Hence Judge, Jury, and a unanimous Court of Appeals found against Petitioner on the facts. On these facts the Petitioner seeks review.

Also studiously omitted in the Petition is any comment as to the actual charge to the Jury instructing them on the law relating to the issues of misuse, purging misuse, as well as patent infringement. This extensive charge appears in Petitioner's Appendix, pp. 14(a)-18(a) terminating with Petitioner's attorney's exchange with the Trial Court.

> "Is that a correct statement, gentlemen?"
>
> Mr. Wagner: [Petitioner's counsel] "That's correct, your Honor." (Petitioner's Appendix 18a)

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* Emphasis supplied throughout unless otherwise noted.

SUMMARY OF REASONS FOR DENYING THE WRIT.

I. Purging misuse is a question of fact. The Jury and Court found it had not been purged. Petitioner argues only factual issues here.

II. Petitioner's failure to seek rehearing before the court of Appeals on the misuse issue precludes its argument here.

III. Patent infringement is a question of fact. The Trial Judge, Jury, Court of Appeals unanimously found no infringement. No argument is made that the Trial Judge *and* Jury were wrong.

IV. CA 4's "sufficiently dissimilar" comments related to the evidence and Not the Jury Charge. Only the Jury instructions can be questioned and they are not.

V. This case conflicts with no other. It has attracted no notoriety despite publication of all opinions in the United States Patent Quarterly, read by most of the Patent, Bar. The single head note in the United States Patent Quarterly is a sterile factual conclusion of non-infringement of Petitioner's patent 3,090,300.

THE WRIT SHOULD BE DENIED.

I. PURGING MISUSE IS A QUESTION OF FACT. THE JURY AND COURT FOUND IT HAD NOT BEEN PURGED. PETITIONER ARGUES ONLY FACTUAL ISSUES HERE.

While *Morton Salt* v. *Suppinger,* 314 U.S. 488 is the most often quoted guideline of this Court as to patent misuse, a companion case *B.B. Chemical* v. *Ellis,* 314 U.S. 495 treated the issue of purging misuse and concluded stating:

> "Despite this contention, petitioner suggests that it is entitled to relief because it is now willing to give unconditional licenses to manufacturers on a royalty basis, which it offers to do. It will be appropriate to consider petitioner's right to relief when it is able to show that it has fully abandoned its present method of restraining competition in the sale of unpatented articles and that the consequences of that practice have been fully dissipated."

To be noted is the extent to which the Trial Court charged the Jury on purging (Petitioner's Appendix 12a-15a).

Petitioner nowhere attacks the charge to the Jury. This is the statement of law. Petitioner nowhere says the Jury finding was against the manifest weight of the evidence.

Petitioner argues the facts in the face of a Trial Court, Jury and unanimous decision of a Court of Appeals. This Court is not the place to challenge the facts.

II. PETITIONER'S FAILURE TO SEEK REHEARING BEFORE THE COURT OF APPEALS ON THE MISUSE ISSUE PRECLUDES ITS ARGUMENT HERE.

The Court of Appeals held the issue of misuse moot. Respondent doesn't care. Respondent Harwell can build his machine. The Appeals Court, like this Court, recognized that all issues, hypothetical or real, do not require decision—only those essential to terminate the dispute between the parties.

Misuse of patents is not to be condoned by this or any other Court. Petitioner never sought rehearing and a decision by the Court of Appeals on the purging of misuse. Petitioner is seeking to wear out Respondent Harwell. Petitioner wants this Court to tell the Court of Appeals to reopen the misuse issue which was mooted by its affirming non infringement.

Petitioner correctly cites Supreme Court Rule 19(1)(b) as the basis for granting Certiorari. However, that rule relates to decisions of a Court of Appeals, and not failing to render a decision.

If this Court takes the issue of purging misuse, it effectively takes direct appellate jurisdiction from the District Court which, pursuant to rule it does not have.

Petitioner, a large international cartel lader, had the means to seek rehearing. He didn't. Respondent Harwell with seven (7) employees (including Mr. and Mrs. Harwell) has neither the means nor does justice require it. We submit that Petitioner is disabled from seeking here what it should have sought before the Court of Appeals.

III. PATENT INFRINGEMENT IS A QUESTION OF FACT. THE JUDGE, JURY, COURT OF APPEALS ALL UNANIMOUSLY FOUND NO INFRINGEMENT. NO ARGUMENT IS MADE THAT THE COURT AND JURY ARE WRONG.

The patent infringement is a question of fact is axiomatic says Walker on Patents, Deller 1937 Edition, the basic treatise on Patent and law:

"405 Infringement Defined.

Invasion or violation of the rights secured by the patent is termed "an infringement" in the statute, but no definition of what constitutes an infringement is given. Infringement is a question of fact, [*Stilz* v. *United States* v. *Societe Anonyme des Anciens Etablissements Cail,* 224 U.S. 309, 332, 56 L. Ed. 778; *Leeds & Catlin Co.* v. *Victor Talking Machine Co.,* 213 U.S. 301, 312, 53 L. Ed. 805; *Continental Paper Bag Co.* v. *Eastern Paper Bag Co.,* 210 U.S. 405. 422. 52 L. Ed. 1122; *Reinharts, Inc.* v. *Caterpillar Tractor Co.,* 85 R.(2d) 628, C.C.A. 9 (1936)

The facts were argued at length at trial and before the Court of Appeals. Everyone held for Respondent on the facts.

Nowhere does Petitioner attack the Jury charge which is the statement of law.We ask this Court's comparison of Mr. Justice Jackson's comments in *Graver* v. *Linde* with Judge McMillan's charge to the Jury:

"In determining whether an accused device or composition infringes a valid patent, resort must be had in the first instance to the words of the claim. If accused matter falls clearly within the claim, infringement is made out and that is the end of it.

But courts have also recognized that to permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent grant into a hollow and useless thing."

• • • • •

"The doctrine of equivalents evolved in response to this experience. The essence of the doctrine is that one may not practice a fraud on a patent. Originating almost a century ago in the Case of *Winans* v. *Denmead*, 15 How. 330, it has been consistently applied by this Court and the lower federal Courts, and continues today ready and available for utilization when the proper circumstances for its application arise. "To temper unsparing logic and prevent an infringer from stealing the benefit of invention" it has been necessary to recognize that "what is claimed is not merely what is described in the words of the definition, but also whatever else is in substance the same thing."

"The plaintiff says that in substance the defendants have copied all of the essential elements of Claim 1 of the patent and that, having copied these elements, they are infringing and should pay damages for that infringement. The plaintiff contends that the system of four parallel shafts in the upper assembly is a new and useful improvement; that the cable, which is in the defendant's machine in lieu of the fourth shaft, really does the same thing; that there is a doctrine they call the doctrine of equivalents which says that if you come up with something that does essentially the same thing in substantially the same way by substantially the same means, then it is an infringement even though it may not look like the original

efit of an invention" a patentee may invoke this doctrine to proceed against the producer of a device "if it performs substantially the same function in substantially the same way to obtain the same results." *Sanitary Refrigerator Co.* v. *Winters*, 280 U.S. 30, 42 [3 USPQ 40, 44]. The theory on which it is founded is that "if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form, or shape." *Machine Co.* v. *Murphy*, 97 U.S. 120, 125.

idea and that under this theory of equivalents that the defendant's invention is about equal to the plaintiff's and that the purpose of the patent law ought to be carried out by holding that the defendant's machine does infringe."

What difference there may be in language fails to hint any deviation in substance.

There is no error of law, nor does Petitioner assert an error of law in the Jury charge on infringement. Thus there is no question on infringement to present to this Court.

IV. CA 4'S "SUFFICIENTLY DISSIMILAR" COMMENTS RELATED TO THE EVIDENCE AND NOT THE JURY CHARGE. ONLY THE JURY INSTRUCTIONS CAN BE QUESTIONED AND THEY ARE NOT.

Petitioner s "Trojan Horse" is the phrase "sufficiently dissimilar." The Court of Appeals used this phrase to characterize the machines it saw. This Court need not pass now on the accuracy of that statement. If the machines were before this Court, and it passed this issue count, it would require this Court to make a factual conclusion. That is no ticket for this ball park.

The Court of Appeals did not say, in substance, that the Jury should have been instructed to determine whether the machines were similar or dissimilar. The Jury was never charged with the "sufficiently dissimilar" language.

Thus it is clear that the term "sufficiently dissimilar" was a comment on the evidence and not, as Petitioner would have this Court believe, a startling new proposition of law.

V. THIS CASE CONFLICTS WITH NO OTHER, HAS ATTRACTED NO NOTORIETY DESPITE PUBLICATION OF ALL OPINIONS IN THE UNITED STATES PATENT QUARTERLY, READ BY MOST OF THE PATENT, BAR. THE SINGLE HEADNOTE IN THE UNITED STATES PATENT QUARTERLY IS A STERILE FACTUAL CONCLUSION OF NON-INFRINGEMENT OF PETITIONER'S PATENT 3,090,300.

We have printed, as our one page appendix, the decision of the Court of Appeals exactly as it appeared in the United States Patent Quarterly. This publication, on December 10, 1973 was circulated to virtually the entire patent bar.

First, we should point out that only one headnote appears, the sterile factual comment:

> "Particular patents—printing 3,090,300, Dubuit, Silk Screen Printing Machine, not infringed."

If this case "departs from accepted judicial procedure" as Petitioner urges presumably some unique point or two of law would have found its way into a headnote. It didn't.

Second, why is there no reference by Petitioner to any publication referencing this decision?

Third, why is there no *amicus* brief? This Court heard *Kewanee Oil* v. *Bicron* 73-187 orally argued on January 9, 1974. Motions for leave to file briefs, as amici curiae, were granted as follows:

> American Patent Law Association,
>
> The Association for the Advancement of Invention and Innovation,
>
> Manufacturing Chemists Association,
>
> The Licensing Executives Society,
>
> Patent Law Association of Chicago,
>
> American Bar Association,
>
> New York Patent Law Association,
>
> The SCM Corporation, and the Solicitor General were invited to file a brief expressing the views of the United States: (Potters Supreme Court News Service, January 21, 1974)

The conclusion is obvious. The issue of infringement went to a jury with an unchallenged charge. The Court of Appeals affirmed. No mistake of law was made.

CONCLUSION.

A ticket to this ball park requires more for admission than a routine case of patent infringement.

The Petition should be denied.

Respectfully submitted,

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RESPONDENT'S APPENDIX

Court of Appeals, Fourth Circuit

DUBUIT et al. v. HARWELL ENTERPRISES, INC., et al.

No. 73-1234 Decided Oct. 15, 1973

PATENTS

Particular patents—Printing

3,090,300, Dubuit, Silk Screen Printing Machine, not infringed.

Appeal from District Court for Western District of North Carolina, McMillan, J.; 178 USPQ 24.

Action by Louis Gilbert Dubuit, Machines Dubuit, and American Screen Process Equipment Company against Harwell Enterprises, Inc., and Roy M. Harwell, Jr., for patent infringement. From judgment for defendants, plaintiffs appeal. Affirmed.

See also 171 USPQ 550, 175 USPQ 484.

ROBERT E. WAGNER, Chicago, Ill. (ROBERT E. BROWNE and WALSH, CASE & COALE, both of Chicago, Ill., and FLOYD A. GIBSON and PARROTT, BELL, SELTZER, PARK & GIBSON, both of Charlotte, N. C., on the brief) for appellants.

JACK E. DOMINIK, Chicago, Ill. (DOMINIK, KNECHTEL, GODULA & DEMEUR, Chicago, Ill., and BASIL L. WHITENER and WHITENER & MITCHEM, both of Gastonia, N. C., on the brief) for appellees.

Before WINTER, BUTZNER, and FIELD, Circuit Judges.

PER CURIAM.

The principal issues on this appeal are whether Louis G. Dubuit's Patent No. 3,090,300 for a silk screen printer is infringed by Harwell Enterprises' machine and whether Harwell libeled Dubuit by circulating a proposed complaint for a declaratory judgment disparaging the means Dubuit had employed in obtaining his patent. Both issues were submitted to a jury, which found neither infringement nor libel.[1] The district judge entered judgment on the verdict. We affirm.

Dubuit protests that the introduction into evidence of Harwell & Yoder's Patent No. 3,545,377 on the accused device was prejudicial. In a pretrial motion, Dubuit's counsel had sought exclusion of the patent, but when it was actually offered as an exhibit during the trial, he said he had no objection. Nor did he object to the court's brief mention of the patent in its charge. Although the patent was not relevant to the issue of infringement, we find no reversible error in this incident of trial.

We find no abuse of discretion on the part of the district court in submitting the case to the jury without the extensive interrogations proposed by Dubuit. And in light of the narrow construction which must be given Dubuit's patent, we conclude that the accused device was sufficiently dissimilar to sustain the jury's finding of noninfringement. Cf. Sterner Lighting, Inc. v. Allied Electrical Supply, Inc., 431 F.2d 539, 543, 166 USPQ 454, 458-459 (5th Cir. 1970). We also conclude that the court committed no error in its submission of the issue of libel to the jury and that the evidence pertaining to this aspect of the case was sufficient to support the jury's verdict. We find no merit in the other assignments of error.

Affirmed.

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[1] The jury also found the Dubuit patent to be valid. The court entered judgment on this finding, and Harwell did not appeal.

Subsidiary issues pertained to patent misuse and the measures taken to purge it. The district court summarily adjudged that an agreement between Machines Dubuit and American Screen Process Equipment Company contained a tying arrangement constituting patent misuse. Dubuit v. Harwell Enterprises, Inc., 336 F.Supp. 1184, 171 USPQ 550 (W.D. N.C. 1971). Whether the contracting parties had purged the misuse was submitted to the jury, which found against Dubuit. These issues have been mooted by the judgment of noninfringement.